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Atty Docket No.: 200310982-1

FEB 09 2006

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor(s): Gary A. Gibson et al.

Confirmation No.: 5476

Serial No.: 10/660,297

Examiner: Aditya S. Bhat

Filed: September 10, 2003

Group Art Unit: 2863

Title: A DATA STORAGE DEVICE AND A METHOD OF READING DATA IN  
A DATA STORAGE DEVICE

**MAIL STOP AF**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

Review of the final rejection in the Office Action dated November 9, 2005 in the above-identified application is respectfully requested. This request is being filed concurrently with a Notice of Appeal and is submitted for the reasons stated on the attached sheets. No amendments are being filed with this request.

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**REMARKS**

Favorable reconsideration of this application is respectfully requested in view of the following remarks. Claims 1-24 are pending in the present application of which claims 1, 13, 23 and 24 are independent.

Claims 1-10, 13-19 and 21-24 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Fujiwara et al. (U.S.P. No. 5,777,977).

Claims 11, 12, and 20 remain allowable, as indicated in a prior Office Action dated May 19, 2005.

**Telephonic Interview Dated December 21, 2005**

The undersigned respectfully thanks the Examiner for the courtesies he extended to Tiep Nguyen, Reg. No. 44,465, in the telephonic interview conducted on December 21, 2005, wherein independent claims 1, 23, 24 and the reference, Fujiwara et al. (5,777,977), was discussed. No agreement as to the allowability of the present application was reached during the interview. However, the Examiner expressed his understanding of Mr. Nguyen's discussion of the difference between claims 1, 23, 24 and Fujiwara et al. The Examiner indicated that he will further review Fujiwara et al. once a Pre-Appeal Brief Request is filed.

**The Examiner committed Clear Errors in the Rejection of Claims 1-10, 13-19, and 21-24 under 35 U.S.C. 102(b)**

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed

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combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claims 1, 13, and 24

Claims 1, 13, and 24 recite, *inter alia*, "sensing a change in the capacitance based on a displacement of the probe tip due to the presence of a bit." Thus, the presence of a bit causes the displacement of the probe tip, which in turn affects a change in the capacitance that is being sensed. In contrast, Fujiwara et al. clearly shows in FIGs. 5 and 7 that the reading head HR having a tip 21 is "kept out of contact with the recording medium 10" (col. 6, ll. 53-54; col. 10, ll. 51-52) during reading, that is, the sensing of the electrostatic capacitance that is represented between the tip 21 and the recording medium 10 (col. 7, ll. 13-14). Thus, there is no "displacement of the probe tip due to the presence of a bit" as claimed because the displacement of the tip 21 is predetermined to be kept out of contact with the recording medium, regardless whether there is the presence of a bit.

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In the telephonic interview, the Examiner posed a broad interpretation of the term "displacement," wherein the tip 21 is "displaced" as it travels over the recording medium 10 to read information thereon. However, as pointed out in the telephonic interview, while the tip 21 may be displaced from one position to another over the recording medium 10, such displacement is not *due* to the presence of a bit. Most likely, the travel path of the tip 21, and "displacement" thereof, is predetermined based on software programming and independent of whether there is the presence of a bit on the recording medium 10 below.

Accordingly, it is respectfully submitted that Fujiwara et al. fail to disclose each and every element of claims 1, 13, and 24, as arranged in the claims. Therefore, it is respectfully submitted that claims 1, 13, 24, and there dependent claims 2-12 and 14-23 are allowable over the references of record.

**Claims 6 and 16**

The Office Action rejects claims 6 and 16 by citing to col. 19, ll. 46-47 of Fujiwara et al., which merely discloses a lower electrode that can be made of Pt. In contrast, claims 6 and 16 recite a conducting thin film "comprises at least one of a deposited metal film of Mo, Cu, TA."

Accordingly, it is respectfully submitted that Fujiwara et al. fail to anticipate claims 6 and 16, and these claims are further allowable over the references of record.

**Conclusion**

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited. Should the Examiner believe that a telephone conference

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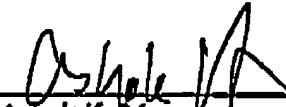
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with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: February 9, 2006

By

  
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